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(4) REMARKS

RESPONSE TO REJECTION UNDER ACTION PARA. 1

No response required.

RESPONSE TO REJECTION UNDER ACTION PARA. 2

The claims have been amended with respect to the noted informalities. Applicant wishes to thank the Examiner for the clear nature of the objections and the proposed solutions. Withdrawal of the objections is respectfully requested.

RESPONSE TO REJECTION UNDER ACTION PARA. 3 & 4

Claims 1-10 were rejected as obvious under Sec. 103(a) in view of U.S. Pat. No. 6,091,409 (Dickman hereinafter).

Independent claim 1 clearly includes: "...one *temporarily* marked location *on said tablet* with a preselected Internet data address wherein *subsequently accessing said marked location* with said stylus triggers a shift to said data address associated with said marked location." Emphases added.

It is axiomatic that claims are not to be interpreted in a vacuum. Slimfold Mfg. Col v. Kinkead Indus.,810 f.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987); Moleculon Res. Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim and specification language must be considered. DMI, Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985). By ignoring the present application's use of the claims limitations as discussed in the Detailed Description, the argument as set forth in the Action ignores this requirement. Understanding, or Interpreting, a limitation *already in a claim* in light of the Detailed Description is not the same as an impermissible reading of a limitation into a claim. Otherwise, these court decisions are

rendered meaningless. This need for consideration of "specification language" is particularly applicable in computer process cases where terms carry a special rather than ordinary (dictionary) meaning.

In general, the Action relies on Dickman's FIGURE 4. Dickman's FIGURE 4 is a known manner computer screen "user interface" (col. 3, ll. 29-31), a virtual desktop 50 with icons 52 (col. 6, ll. 40-49). It is like present applicant's FIG. 1 (Prior Art), FIG. 2A, B, as to elements 201, 209. The present application disclosure is on its face not directed to such semi-permanent screen icon implementations.

The Action further relies on Col. 4, ll. 42-46, of Dickman. It reads:

> "...Internet shortcuts may be dragged and dropped. The Internet shortcuts encapsulate URLs (or other location information) and other information. The Internet shortcuts are implemented as objects that are visible within the shell name space."

These are not freehand drawn sponteaneous symbols by the user as taught and claimed in the present application; they are merely known manner fixed icons to fixed sites, shown by Dickman, for example, as "Inbox" or user applications "Shortcut to Ms." There is no spontaneous association as described and claimed in the present application. This is clearly not a "computer annotator system" shown by applicant and claimed as a "system," including a handwriting recognition tablet 205. In fact, the Action admits at Page 3 that "Dickman however does not teach that in an electronic table (sic, tablet) with a marketing (sic, marking) stylus be used with the system."

There are several specific and significant differences with respect to the problem and solution addressed by Dickman. Dickman's "internet shortcuts" are, by design, persistent rather than temporary. Each of Dickman's shortcuts is implemented as an object that supports a Microsoft Object Linking and Embedding (OLE) interface - - see Col. 7, ll. 39-43 - - intended to provided persistence of stored data objects - screen icons - which do not disappear whenever the user ends a session or logs-out. Such desktop iconic shortcuts are a quick way to access frequently referenced resources. To be effective, such shortcuts point to permanent objects. For

example, many users have shortcuts which link to frequently used programs such as an e-mail reader or an Internet browser to invoke the whole program. Dickman's Internet shortcuts are iconic links to frequently accessed Internet addresses ("URLs") which are generally sites with well-known URL's, e.g. "Amazon.com." It is not practical to create such shortcuts to a page which disappears as soon as a session is completed, e.g. to an Amazon.com "shopping cart." Thus Dickman's shortcuts are no more relevant than conventional browser bookmarks previously addressed in response to the first Office Action. Long-term referencing is Dickman's goal rather than a transient usage as shown in the exemplary embodiments of the present application.

To the opposite effect, the present disclosure is to exemplary embodiments which may be optimized for ephemeral URLs such as those encountered during Internet searches where such may be constructed on-the-fly by web servers as needed.

The rejection should be withdrawn based on this ground alone. However, the Office made other arguments.

The Office Action also alleges that

> "It would have been simple to utilize a tablet and stylus as an input manipulation means, . . .because of the extreme conventionality of the input device and its common use as a substitute to the mouse input device."

Input manipulation is not sufficient. Dickman's Internet shortcuts use graphical icons to represent the URLs. As a result, Dickman's invention requires an interface that supports both input and output, in particular, an output capability sufficient to do medium resolution graphics to display the icons themselves. Thus, it is not an obvious implementation nor combination to achieve the temporary association described by the present applicant. In any event, nothing in Dickman itself suggests nor motivates such a combination.

The present disclosure describes and claims a simple digitizer tablet. It is known that such simple digitizing tables operate in either of two mutually exclusive modes: "relative coordinate"

or "absolute coordinate." In the relative coordinate mode, movement of the tablet's stylus is sensed with respect to the stylus' current position - - for example, a stylus movement to the left indicates a leftward movement regardless of where on the table the stylus is resting. A digitizer table operating in a relative coordinate mode would emulate the behavior usually associated with a mouse. To utilize a tablet as a mouse substitute, Dickman would need to use a relative mode. Again, there is no suggestion nor motivation in Dickman itself for such an implementation.

Moreover, to the contrary, the present invention exploits the absolute coordinate mode capability of a digitizer tablet, claiming ". . .associating at least on temporarily marked location. . .." Absolute mode is quite different from relative mode; the tablet's stylus position is sensed with respect to the exact location of the stylus on the tablet - - for example, a stylus movement in the upper left corner of the tablet is completely different from a stylus movement in the lower right corner of the tablet. The absolute coordinate system of the tablet enable the described embodiments of the present invention to process the arbitrary mnemonic symbols written at arbitrary locations.

Again, based on these facts, the rejection should be withdrawn.

The Action continues in a specific argument that regarding claim 2,

> ". . .Dickman teaches a surface region where the annotating function is implemented, namely the shell space or desktop. . .."

Again, this is an extrapolation of the actual language of Dickman which clearly defines the iconic shortcuts as persistent data structures that must be manipulated within the Windows desktop.

Again, based on this fact, the rejection should be withdrawn.

The Action continues in a specific argument against claim 3, referring to Dickman's FIG. 9d as having

". . .a second region accessible by the input device where an image indicative of the address is entered."

Again, this aspect as defined in the present disclosure is not found in the Dickman disclosure. FIG. 9d only shown an Internet shortcut residing within a "Favorites" folder. This "second region" is just a conventional Windows folder, not a temporary association symbol in freehand on a tablet. Since Dickman's shortcuts are Windows objects (Col. 7, ll. 12-14), they can be stored in a folder in the same way that file system icons can be stored in a file folder. This is not the disclosure nor claim of the present invention.

The Action continues, alleging claims 8-10 are rejected on the same grounds as claims 5-7 and that claims 5-7, 11-15, and 17-20 are rejected per the first Office Action and further addressed in Para. 5 of the Final Office Action, discussed in the next Section hereinbelow.

In summary, Nothing in Dickman discloses, suggests, nor motivates such the elements and functions as described and claimed in the present invention. In fact, in summary, a given, point-and-click icon fixed on a screen as shown by Dickman, and a staple of Microsoft Windows and other Internet access short devices as mentioned by the Examiner at Page 4, last line, is an opposite concept to such a spontaneous association between an Internet site and a freehand associative symbol. Proceeding contrary to the wisdom of the prior art is "strong evidence" of non-obviousness. W.L. Gore & Assoc., Inc. V. Garlock, 220 USPQ 303 (CA FC 1983).

Withdrawal of all the rejections is respectfully requested.

RESPONSE TO REJECTION UNDER ACTION PARA. 5

Regarding claims 1-3 and 8-10, it is not clear whether the suggestions with respect to Claims 1-3, and 8 in para. 2 of the Action were the recommendations referring to this paragraph. Clarification is respectfully requested. See also, Petition, filed herewith. Moreover, the Remarks with respect to Dickman make it clear that there is clearly a different invention claimed.

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Regarding claims 5-7 rejected under Sec. 102 re: Makino. The Action states,

> ". . .the claim can still be anticipated by Dickman since it is well known to people skilled in the art since 1995, that shortcuts are inherently designed to be place in random locations, erased, and be place over the desktop in random locations."

In In re Newell, 13 USPQ2d 1248, 891 F.2d 899 (Fed. Cir. 1989) the court explicitly stated that:

> "[I]n deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art."; "[A] retrospective view of *inherency* is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination." (At 1250, emphasis added.)

It is respectfully submitted that the rejection is deficient and should be withdrawn.

Regarding claim 15, the Examiner argues the claimed element

> "...computer code for accessing said address. . .highly resembles a macro, a series of computer code associated to perform a function...anticipated by Dupony (sic, Dupouy)."

The claim must be considered as a whole; applicant claims code where the inter-relationship of "temporary symbols" recorded by the user can be used to access the Internet site. This is not shown in the reference. Withdrawal of the rejection is respectfully requested.

Regarding claims 11, 12, and 14, applicant claims: "...associating an address of the site with a writable-erasable mnemonic device in a computer writing tablet." A reference under Sec. 102 must contain disclosure of such a feature to anticipate the claim. Dupouy has no such element. Claims 12 and 14 are dependent on independent claim 11. A dependent claim includes all the limitations of the claim from which it depends and, as such, makes specific that which was general. 35 USC 112; 37 C.F.R. Sec. 1.75(c); Allen Group, Inc. V. Nu-Star, Inc., 197 USPQ 849 (7th Cir. 1978); Ex parte Hansen, 99 USPQ 319 (Pat. Off. Bd. App. 1953). Dependent claims are non-obvious if the independent claims from which they depend are non-obvious. In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); *see also* Hartness International, Inc. V. Simplimatic Engineering Co., 2 USPQ2d 1826, 1831 (Fed. Cir. (1987) to the same effect re

novelty). Thus, allowance of a base claim as patentable normally results in allowance of a claim dependent upon that claim. Withdrawal of the rejection is respectfully requested.

SUMMARY AND CONCLUSION

Applicant has shown specific technical differences above which eliminate all the references cited. Moreover, legal reasons for rejection of each of the references has been raised. Therefore, all grounds for rejection have been overcome.

Based upon the foregoing, it is submitted that the application now presents claims which are directed to novel, unobvious and distinct features of the present invention which are an advancement to the state of the art. Reconsideration and early allowance of all claims is respectfully requested. The right is expressly reserved to reassert any and all arguments, including the raising of new arguments, should a Notice of Allowance not be forthcoming. Applicant reserves the right to reinsert claims and to prosecute claims via continuing and divisional applications.

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Questions or suggestions that will advance the case to allowance may be directed to the undersigned by teleconference at the Examiner's convenience.

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Respectfully submitted,
Hewlett-Packard Company

Eugene H. Valet

Eugene H. Valet
Attorney Reg. No. 31435
(425) 672-3147 fax 640–0525

Eugene H. Valet
Valet.Patents@verizon.net
314 10th Ave. South
Edmonds WA 98020[1]//

[1] Do not change formal correspondence address; unless PTO/SB/122 is filed herewith, formal correspondence continues to be directed to Hewlett-Packard per the Declaration